IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number : 10/712,938   Confirmation No. 9539

Applicant : Darshan Timbadia, et al.

Filed : November 13, 2003

Tech Cntr/GAU : 3715

Examiner : Kathleen Michele Mosser

Entitled : SYSTEMS AND METHODS FOR TESTING OVER
A DISTRIBUTED NETWORK

Attorney Docket No. (OLD): 128534-00701 (07027463)
Attorney Docket No. (NEW): 011948-0015-999-00701

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

TRANSMITTAL FOR CORRECTED APPEAL BRIEF

In response to the Notification of Non-Compliant Appeal Brief dated July 7, 2009

(copy attached hereto), transmitted herewith is a Corrected Appeal Brief for this application.

EXTENSION OF TIME

A petition for extension of time under 37 C.F.R. 1.136 is not believed necessary.

FEE PAYMENT

Payment of the fee for the Appeal Brief (Fee Code 1402) was previously authorized on

May 26, 2009 with the initial filing of the Appeal Brief. Authorization is given to charge any

deficiencies in the fees, and/or to further credit any overpayments, to Deposit Account No. 503-

013 to proceed with consideration of the attached Appeal Brief and to maintain the pendency of

this application.

Respectfully Submitted,

JONES DAY

Date: August 7, 2009 By: _____
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UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Notification of Non-Compliant Appeal Brief (37 CFR 41.37)	Application No. 10/712,938	Applicant(s) TIMBADIA ET AL.
	Examiner MOSSER, KATHLEEN	Art Unit 3715
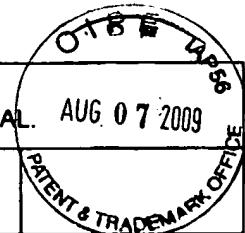
--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on *May 26, 2009* is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☐ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.

2. ☒ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).

3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).

4. ☐ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).

5. ☐ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi))

6. ☐ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).

7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).

8. ☐ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner **and relied upon by appellant in the appeal**, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).

9. ☐ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).

10. ☐ Other (including any explanation in support of the above items):

Item 2. The Appeal Brief fails to provide the status of all the claims filed in the application.

Please note, the entire Appeal Brief is not required only the defective area .

LORENDA HOOD
PATENT APPEAL CENTER SPECIALIST

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Timbadia, et al.	Art Unit: 3715
Application No.: 10/712,938	Examiner: Kathleen Michele Mosser
Filed: November 13, 2003	Atty. Docket (old): 128534-00701 (07027463)
	Atty. Docket (new): 011948-0015-999-00701
For: SYSTEMS AND METHODS FOR TESTING OVER A DISTRIBUTED NETWORK	

APPELLANT'S CORRECTED APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Corrected Appeal Brief is filed in response to the Notification of Non-Compliant Appeal Brief mailed July 7, 2009. This Corrected Appeal Brief is also filed in response to the final Office Action mailed January 7, 2009, which finally rejected claims 1, 13, and 20 of the instant application. An after-final Response was filed by applicant on March 5, 2009, which was entered by the Examiner as indicated in the Advisory Action mailed on March 24, 2009. A Notice of Appeal was filed on March 25, 2009.

The required fee of $270.00 (small entity) for an Appeal Brief was previously paid on May 26, 2009. The Commissioner is hereby authorized to charge any deficiencies and to credit any overpayment associated with this Appeal to Jones Day Deposit Account No. 503-013.

I. Real Parties In Interest

The real party in interest is Educational Testing Service as evidenced by an assignment recorded at Reel/Frame 014706/0764.

II. Related Appeals And Interferences

There are no related appeals or interferences to the instant application.

III. Status Of Claims

Claims 1, 13, and 20 are pending and are finally rejected. Claims 1, 13, and 20 are independent claims. Claims 2-12, 14-19, and 21-27 are canceled. The rejections of claims 1, 13, and 20 are now appealed.

IV. Status Of Amendments

An after-final Response was filed on March 5, 2009, making minor changes to claim 1. The after-final Response was entered by the Examiner, as indicated in the Advisory Action mailed March 24, 2009. No additional amendments have been filed since the Final Office Action of January 7, 2009.

V. Summary Of Claimed Subject Matter

The claimed subject matter of independent claims 1, 13, and 20 relates to systems and methods for administering an examination and managing the state of an examination. Traditionally, standardized tests have been paper-based, whereby examinees are gathered in a room and given paper test materials, usually comprising a question booklet and an answer sheet that is computer-readable by optical or magnetic means. With the growth of the

computer industry and the reduction in price of computing equipment, fields in which information has traditionally been distributed on paper have begun to convert to electronic information distribution means. (page 1, lines 14-19.)

While systems for computer-based testing have been available, they have generally relied on outdated technologies, such as physical delivery of test questions and related software. While physical delivery of data and software on data storage media is reliable and secure, it is slow and cumbersome because it has a built-in lag time (*i.e.*, the time it takes to deliver the medium), and it requires a person to physically handle the delivery medium. While installation of initial testing materials on physical media may be acceptable, using physical media to provide recurring updates to the materials may, in some cases, be unacceptably cumbersome. With advances in networking, as exemplified by the growth in the capacity and usage of the Internet, network communication is quickly supplanting physical delivery in many contexts. Modern expectations demand no less than the speed that network communications can provide, while still retaining the security and reliability of physical delivery. In the testing context, the need to preserve security and reliability when introducing network distribution cannot be overemphasized. (page 2, lines 1-14.)

The subject matter of independent claims 1, 13, and 20 offers significant advantages in the realm of computer-based testing by introducing advantages of networked computing while implementing novel state management concepts that mitigate inherent obstacles, such as testing station failures. (Abstract.) Following is a discussion of each of the independent claims that includes notations of examples and support for the recited features in parenthesis.

A.   **Independent Claim 1**

Independent claim 1 is directed to a system for administering an examination. An exemplary implementation of the claimed system for administering an examination is shown in FIG. 1. One or more testing stations (FIG. 1: 111a, 111b, 111c, 111n) are configured to

receive a plurality of test items (page 7, lines 18-23), to display the test items to a user (page 6, line 21 to page 7, line 4), to record state information comprising: time elapsed from the start of the examination (page 12, lines 1-10), identification of test items displayed to the user (page 12, lines 1-10), and user interactions with the testing stations (page 12, line 11 to page 13, line 7). The one or more testing stations transmit changes to the state information at the same time that the state information is recorded (page 12, line 11 to page 13, line 7) including when the user provides responses to the test items (page 12, line 11 to page 13, line 7).

The system for administering an examination also includes a first server computer system (FIG. 1: 120) in communication with the one or more testing stations. The first server computer system is configured to electronically transmit the test items to the one or more testing stations (page 8, lines 5-12), receive user information and responses to the test items from the one or more testing stations (page 8, lines 5-12), receive the state information from the one or more testing stations (page 8, line 13 to page 9, line 4), and electronically store the state information at the same time that the state information is received (page 8, line 13 to page 9, line 4).

The system further includes a second server communication system (Fig. 1: 130) in communication with the first server computer system. The second server computer system is configured to receive user information and responses to the test items (page 10, lines 5-23) from the first server computer system and to deliver test packages (page 10, lines 5-23) to the first server computer system.

The system for administering an examination of claim 1 further requires that upon the failure of a testing station (page 11, lines 13-22), an initial state object and the changed state objects (page 12, line 11 to page 13, line 7) are used to recreate the examination on the testing station at the point in the examination where the failure occurred (page 11, lines 13-22). The user is not penalized for the time that questions are not available (page 12, lines 1-10). The

user is able to restart his examination at substantially the same point that the testing station failed through utilization of state data, which includes the elapsed test time (page 11, lines 13-22).

B.   Independent Claim 13

Independent claim 13 is directed to a method of administering an examination to a user over a distributed network. The method includes synchronizing an initial state object (page 12, line 11 to page 13, line 7) on a server (FIG. 1: 120) and on one or more testing stations (FIG. 1: 111) in communication with the server. The initial state object includes the time within which the examination must be completed and the test items to be presented to the user (page 12, line 11 to page 13, line 7). A plurality of test items are delivered to one or more testing stations (page 7, lines 18-23), and the plurality of test items are displayed to the user with user response recorded (page 8, line 13 to page 9, line 4). The method also includes delivering to the server a changed state object (page 12, line 11 to page 13, line 7). The changed state object includes the time elapsed in the examination, the test items presented to the user, and the user's responses to the test items (page 12, lines 1-10). The changed state object is delivered at the same time that a triggering event occurs (page 12, line 11 to page 13, line 7), where the triggering event includes the user providing a response to a test item (page 12, line 11 to page 13, line 7).

The method of claim 13 further requires that upon the failure of a testing station (page 11, lines 13-22), an initial state object and the changed state objects (page 12, line 11 to page 13, line 7) are used to recreate the examination on the testing station at the point in the examination where the failure occurred (page 11, lines 13-22). The user is not penalized for the time that questions are not available (page 12, lines 1-10). The user is able to restart his examination at substantially the same point that the testing station failed through utilization of state data, which includes the elapsed test time (page 11, lines 13-22).

C.   Independent Claim 20

Independent claim 20 is directed to a method of managing the state of an examination. The method includes delivering identification of the examination to be administered (page 9, lines 12-21) on one or more testing stations (FIG. 1: 111) to a server computer (FIG. 1: 120). An initial state object is created on the server computer (page 12, line 11 to page 13, line 7) where the initial state object defines the initial state of the examination. The initial state object is delivered to the one or more testing stations (page 12, line 11 to page 13, line 7). Each user interaction with the one or more testing stations is recorded (page 12, line 11 to page 13, line 7). The changes to the initial state object are delivered from the one or more testing stations to the server computer based on each user interaction (page 12, line 11 to page 13, line 7) at the same time that each user interaction occurs (page 12, line 11 to page 13, line 7).

The method further includes restarting the examination following failure of the testing station (page 11, lines 13-22), where the initial state object and the changed state objects (page 12, line 11 to page 13, line 7) are used to recreate the examination on the testing station at the point in the examination where the failure occurred (page 11, lines 13-22). The user is not penalized for the time that questions are not available (page 12, lines 1-10). The user is able to restart his examination at substantially the same point that the testing station failed through utilization of state data, which includes the elapsed test time (page 11, lines 13-22).

VI.   Grounds Of Rejection To Be Reviewed On Appeal

Claims 1, 13, and 20 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kershaw (U.S. Patent No. 5,565,316) in view of Ashley (U.S. Patent Pub. No. 2004/0229199). These rejections are appealed.

VII. Argument

Claim 1

The rejection of independent claim 1 as being unpatentable over Kershaw in view of Ashley is improper. The present application should is entitled to a priority date of at least November 13, 2002. Ashley claims priority to a provisional application filed on April 16, 2003. Because Ashley's priority date does not predate the priority date of the present application, Ashley is not proper prior art for the 35 U.S.C. § 103 rejection claim 1. Because Ashley is not proper prior art, and because the final Office action of January 7, 2009, admits that Kershaw does not teach certain features of claim 1, a *prima facie* case for the unpatentability of claim 1 has not been made. Therefore, the § 103 rejection of claim 1 should be overturned. Furthermore, Ashley does not teach or suggest transmitting changes to the state information at the same time that the user provides responses to the test items, contrary to what is suggested by the Office. Therefore, the § 103 rejection of claim 1 should be also be overturned for at least these reasons as failing to make a *prima facie* case for the obviousness of claim 1.

A. The Final Office Action Erroneously Rejects the Present Application's Priority Claim to U.S. Provisional Application No. 60/425,740

The present application includes a priority claim to U.S. Provisional Application 60/425,740 ("the Provisional Application"), filed on November 13, 2002. In the final Office action of January 7, 2009, the Office takes the position that applicant has not complied with one of the conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 119(e). More specifically, the Office argues that the disclosure of the prior-filed application, 60/425,740, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. § 112. The Office action states that the "prior

application fails to adequately disclose the limitations of 'upon failure of the testing station, the initial state object and the changed state objects stored on the server are used to recreate the examination on the testing station at the point in the examination where the failure occurred' and that 'the user will not be penalized for the time that questions are not available', as recited in claims 1, 13, 20." Thus, the Office action of January 7, 2009, accords the present application a priority date commensurate with the filing of the instant application of November 13, 2003, on grounds that the final "wherein" clause of claim 1 lacks proper § 112 support in the Provisional Application.

Applicant submits that the final "wherein" clause does have proper § 112, ¶ 1, support and enablement from the Provisional Application. As noted in the after-final response of March 5, 2009, the general concepts of the final wherein clause are discussed throughout the Provisional Application, including at: page 2, lines 28-30; page 3, lines 1-3; and page 5, lines 26-28. Additionally, the failure recovery concepts are described in detail in the "State Management" section on page 10, line 5, to page 11, line 27. Pinpoint citations to discussions of each of the elements of the final wherein clause of claim 1 are illustrated below.

The final wherein clause of claim 1 requires:

wherein upon failure of the testing station, an initial state object and changed state objects stored on the server are used to recreate the examination on the testing station at the point in the examination where the failure occurred, and wherein the user will not be penalized for the time that questions are not available.

This clause contains the following requirements:

- use of objects stored on the server to recreate the examination on the testing station at the point in the examination where the failure occurred;
- the objects include an initial state object and changed state objects; and
- the user is not be penalized for the time that questions are not available.

1. There is ample support in the Provisional Application for using objects stored on the server to recreate the examination on the testing station at the point in the examination where the failure occurred

The general concept of using the test state to recover from a failure of a testing station is illustrated in FIG. 3 of the Provisional Application at 340-350, described therein at page 11, lines 20-27, included below:

300

```
        ┌─────────────────┐
        │    RECEIVE       │──┐ 310
        │  REGISTRATION    │  │
        │  INFORMATION     │
        └─────────────────┘
                │
        ┌─────────────────┐
        │  RECEIVE TEST    │──┐ 320
        │ STATE PERIODICALLY│
        └─────────────────┘
                │
        ┌─────────────────┐
        │ RECEIVE TEST STATE│──┐ 330
        │ UPON DETECTION OF │
        │   USER ACTION     │
        └─────────────────┘
                │
        ┌─────────────────┐
        │ DETERMINE FAILURE │──┐ 340
        │ OF TESTING STATION│
        └─────────────────┘
                │
        ┌─────────────────┐
        │ TRANSMIT STORED STATE│──┐ 350
        │ TO OPERABLE TESTING │
        │     STATION       │
        └─────────────────┘
                │
        ┌─────────────────┐
        │  DELETE COPY OF   │──┐ 360
        │  TEST STATE UPON  │
        │ COMPLETION OF TEST│
        └─────────────────┘
```
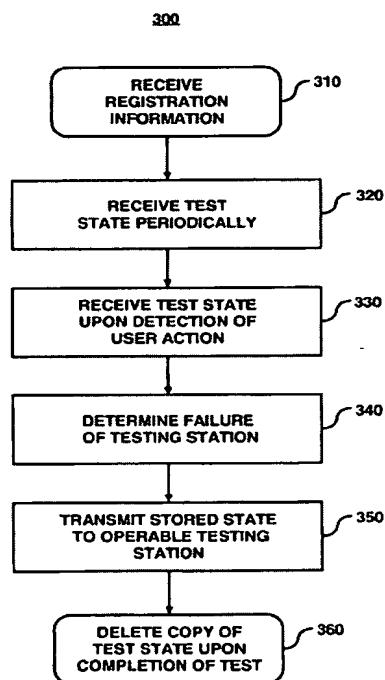
FIG. 3

In step 340, the service center 120 determines failure of the testing station 130a administering the test. For example, upon a timeout for periodically receiving transmissions from the testing station 120a, the service center 120 determines that the testing station 130a failed.

In step 350, the service center 120a transmits the stored test state to an operable testing station where the user can resume taking the test. In step 360, the service center 120 may delete its copy of the test state upon notification of the completion of the test. (Emphasis added.)

Using the test state to recover from a testing station failure is also described at page 10, lines 6-11 of the Provisional Application, which state:

> The service center 120 is operable to perform state management for the system 100. <u>The service center 120 may store a mirror copy of a test state for a test currently being administered. Therefore, if a testing station, such as one of the testing stations 130a... n, administering a test fails, the test being administered may be recovered from the service center 120.</u> Then, the user can complete the test starting from the state of the test at the time of failure. (Emphasis added.)

It is submitted that the bold portion of the above paragraph provides sufficient support for the objects being stored on the server. It is further submitted that the above-noted portions of the figures and disclosure of the Provisional Application provide sufficient support for the objects stored on the server being used to recreate the examination on the testing station at the point in the examination where the failure occurred.

2. There is ample support in the Provisional Application for the objects including an initial state object and changed state objects

With regard to the objects including an initial state object and changed state objects, the Advisory Action of March 24, 2009, objects to applicant's notation of support stating that the "concept of an initial state object is completely void from the [P]rovisional [A]pplication." Applicant respectfully submits that the Office's contention is incorrect. As noted above, a test being administered may be recovered based on a stored test state (page 10, lines 6-11). To alleviate the overhead related to sending the entire state object from the testing station to a server on each server update, the Provisional Application describes maintaining a mirror copy of the test state via an initial transmission of the test state at 220 of FIG. 2 and then delta test state transmissions at 240. Thus, the current state is made up of the combination of the initial test state transmission (an initial state object) and subsequent delta

transmissions (changed state objects). This procedure is described at page 10, line 26, to

page 11, line 4, of the Provisional Application, which states:

> Figure 2 illustrates a method 200 for performing state
> management in a testing station in the system 100, according to
> an embodiment of the invention. In step 210, the administration
> of a test, for example on the testing station 130a, is started. In
> step 220, the testing station 130a transmits the test state,
> including an elapsed time which may be zero and the user's
> answers if any, at the beginning of the test and periodically
> thereafter. Transmission of the test state may include a delta of
> the previous test state to minimize the amount of data being
> periodically transmitted. Also, prior to beginning the test, the
> testing station 130a and/or the administrator station 135
> transmits the user's registration information, including
> information identifying the user and the test.

Applicant submits that the test state transmission at 220 that includes an elapsed time

which may be zero and the user's answers if any corresponds with the initial state object of

the final wherein clause. Applicant further submits that the delta test state transmissions

correspond with the changed state objects of the final wherein clause.

3. There is ample support in the Provisional Application for the user not being penalized for the time that questions are not available

With regard to the user not being penalized for the time that questions are not

available, in the after-final response of March 5, 2009, applicant noted that the exact

language of this portion of the final wherein clause is found at page 10, line 19, of the

Provisional Application. For context, the entire paragraph containing this disclosure, page

10, lines 13-19, is reproduced below with the exact language of the claim language from the

final wherein clause of claim 1 underlined:

> The test state includes, inter alia, an elapsed test time and a
> user's answers. The elapsed test time includes an amount of test
> taking time that has elapsed from a starting time of a test being
> administered. The elapsed test time takes into consideration
> any amount of time that a test is unavailable to the user while
> the test is being administered. **For example**, portions of the test

may be downloaded during administration of the test. Due to transmission latency, questions may not be available to the user. If the user is allotted a predetermined amount of time to take the test, <u>the user will not be penalized for the time the questions are not available to the user</u>. (Emphasis added.)

The Advisory Action of March 24, 2009, takes the position that:

> Though this phrase is used in the [P]rovisional, it is used in a wholly different context than that which is claimed. As reproduced in the response (first full paragraph of page 7) this statement is made in combination with the calculation of the elapsed time of the exam. This section further describes a manner for accounting for transmission latency of questions to users and not penalizing the user for this period of time. This is not a function of the recovery process where an initial and changed state object are used to create the examination, as the step is claimed in connection with.

It is submitted that the above-noted position of the Office stated in the Advisory Action is incorrect. The above-cited paragraph of the Provisional Application (page 10, lines 13-190 describes the tracking of the elapsed time. The elapsed time is part of the test state. As noted at page 11, lines 25-26, of the Provisional Application, the test state is used in resuming a test session following a failure of a testing station. As highlighted in the page 10, lines 13-19, quotation above, the elapsed test time (which is part of the test state, which is utilized in failure recovery) takes into consideration **any** amount of time that a test is unavailable to the user while the test is being administered. The quotation then gives an example of a situation of a time period not being charged to a user's elapsed time. (See the highlighted "For example," in above-noted quotation of page 10, lines 13-19.) Another such situation where a test is unavailable to the user is where the testing station fails. This is clearly contemplated by the Provisional Application since, for example, on recovery, "the user can complete the test starting from the state of the test <u>at the time of the failure</u>." (page 10, lines 10-11) Penalizing the user for time that the questions are not available during a testing station failure could not produce this stated result. Therefore, it is submitted that the

cited portion of the Provisional Application contemplates and fully supports the last portion of the final wherein clause.

Because proper § 112, ¶ 1, support has been demonstrated in the Provisional Application for each portion of the final wherein clause of claim 1, it is submitted that the Office's denial of the application's priority claim to the Provisional Application is improper. Therefore, it is requested that the Board find that claim 1 is to be afforded a priority date of at least November 13, 2002, corresponding to the filing date of the Provisional Application.

B. Ashley is not proper prior art for the 35 U.S.C. § 103 rejection, and therefore the rejection should be overturned.

Ashley (U.S. Patent Pub. No. 2004/0229199), filed on April 15, 2004, claims priority to U.S. Provisional Application 60/463,244, filed on April 16, 2003. As noted above, claim 1 of the present application should be accorded a priority date of November 13, 2002. Because the priority date of claim 1 predates the earliest possible priority date of Ashley, Ashley is not proper prior art for a rejection under 35 U.S.C. § 103.

Because Ashley is not proper prior art, and because the final Office action of January 7, 2009, rejecting claim 1 based on Kershaw and Ashley admits that Kershaw does not teach that the state information is transmitted at the same time that the state information is received including when the user provides responses to the test items, it is submitted that a *prima facie* case for the obviousness of claim 1 has not been made. Therefore, it is requested that the Board overturn the 35 U.S.C. § 103(a) rejection of claim 1 and instruct that claim 1 be allowed.

C. **Ashley does not teach or suggest transmitting changes to the state information at the same time that the user provides responses to the test items, and therefore the rejection should be overturned.**

The first-listed clause of claim 1 requires that the one or more testing stations transmit changes to the state information at the same time that the state information is recorded, including when the user provides responses to the test items. In rejecting claim 1, the Office cites to paragraph [0111] of Ashley as allegedly teaching this claim feature. Paragraph [0111] of Ashley states:

> [0111] The student responses are incrementally encrypted and saved to the local disk, and simultaneously passed to the local satellite server.

The Office's assertion that paragraph [0111] of Ashley teaches or suggests transmitting state information <u>at the same time</u> that the user provides responses to the test items is not supported by this disclosure of Ashley. Paragraph [0111] of Ashley contains no disclosure as to when the student responses are incrementally encrypted and saved to the local disk, nor does Ashley contain any disclosure as to the specific "increment" used in the encryption and saving to disk. Rather, Ashley is entire silent as to these aspects. Because there is no explicit disclosure as to the frequency of the encryption, saving, and passing of responses to the satellite server, the Office's assumption that these activities occur simultaneously with each student response is plainly mistaken. Thus, the Office's assertion that Ashley teaches transmitting state information at the same time that the user provides responses to the test items is erroneous. Accordingly, the rejection should be overturned for at least this additional reason.

If the Office is implicitly relying upon an inherency argument to suggest that Ashley teaches transmitting state information at the same time that the user provides responses to the test items, such reliance is likewise erroneous. As the Office is well aware, and as noted at

MPEP § 2112, "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic <u>necessarily</u> flows from the teachings of the applied prior art" *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App & Inter. 1990) (Emphasis original.) "Inherency, however, may not be established by probabilities and possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). In this case, the Office has provided no evidence to suggest that paragraph [0111] of Ashley necessarily leads to a finding therein of transmitting state information at the same time that the user provides responses to the test items. In addition, as noted above, Ashley is silent as to the timing of encryption, saving to disk and passing information to the satellite server relative to the timing of student responses, and there is no indication in Ashley that certain timings or certain increments are excluded Thus, an inherency argument regarding this claim limitation could not be persuasive. Accordingly, the rejection should be overturned for at least this additional reason.

Claims 13 and 20

Claim 13 contains the identical final wherein clause as claim 1 based on which the Office has improperly denied the claim of priority to the Provisional Application. The last-listed step of claim 20 is substantively similar to the final wherein clause, differing somewhat in form. The final Office action of January 7, 2009, rejects the priority claims of claims 13 and 20 for similar reasons as claim 1. Each of these clauses finds proper § 112 support in the sections of the Provisional Application noted above in the discussion of claim 1. Because the clauses are properly supported, claims 13 and 20 should be afforded a priority date of November 13, 2002.

Claims 13 and 20 stand rejected under 35 U.S.C. § 103(a) based on Kershaw and Ashley for identical reasons as claim 1. The Office admits that Kershaw does not explicitly teach several of the claimed features, relying on Ashley. Because Ashley's earliest priority date does not predate the proper priority date of claims 13 and 20, a proper teaching or suggesting of these claimed features has not been cited. Because a *prima facie* case for the obviousness of claims 13 and 20 has not been made, it is requested that the Board overturn the 35 U.S.C. § 103(a) rejections of claims 13 and 20.

Claims 13 and 20 also contain claim features regarding the transfer of state information at the same time that a user provides a response to a test item. The Office relies on Ashley as teaching or suggesting these claim features. As noted above, Ashley does not explicitly or inherently teach this claim feature. Therefore, it is requested that the Board overturn the 35 U.S.C. § 103(a) rejections of claims 13 and 20 for this reason as well for similar reasoning as offered above for claim 1.

VIII.   Claims Appendix

A claims appendix containing a copy of the claims subject to this appeal is attached.

IX.   Evidence Appendix

No evidence is being submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132, nor is there any other evidence entered by the Examiner or relied upon by the Applicant. An evidence appendix indicating "None" is attached.

X.   Related Proceedings Appendix

There are no related proceedings. A related proceedings appendix indicating "None"

is attached.

Respectfully submitted,

Date: August 7, 2009
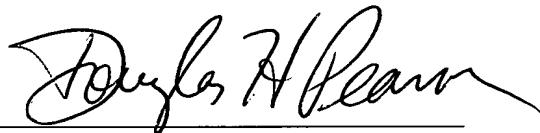
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CLAIMS APPENDIX

1. (Previously Presented) A system for administering an examination comprising:

one or more testing stations, configured to receive a plurality of test items, to display the test items to a user, to record state information comprising time elapsed from the start of the examination, identification of test items displayed to the user, and user interactions with the testing stations, and to transmit changes to the state information at the same time that the state information is recorded including when the user provides responses to the test items;

a first server computer system in communication with the one or more testing stations, wherein the first server computer system is configured to electronically transmit the test items to the one or more testing stations, receive user information and responses to the test items from the one or more testing stations, receive the state information from the one or more testing stations, and electronically store the state information at the same time that the state information is received; and

a second server computer system in communication with the first server computer system, wherein the second server computer system is configured to receive user information and responses to the test items from the first server computer system and to deliver test packages to the first server computer system,

wherein upon failure of the testing station, an initial state object and changed state objects stored on the server are used to recreate the examination on the testing station at the point in the examination where the failure occurred, and wherein the user will not be penalized for the time that questions are not available.

2-12. (Canceled)

13. (Previously Presented) A method of administering an examination to a user over a distributed network comprising:

synchronizing an initial state object on a server and on one or more testing stations in communication with the server, wherein the initial state object comprises the time within which the examination must be completed and the test items to be presented to the user;

delivering a plurality of test items to one or more testing stations;

displaying the plurality of test items to the user and recording the user's responses; and

delivering to the server a changed state object comprising the time elapsed in the examination, the test items presented to the user, and the user's responses to the test items at the same time that a triggering event occurs on the testing station, wherein the triggering event comprises the user providing a response to a test item,

wherein upon failure of the testing station, the initial state object and the changed state objects stored on the server are used to recreate the examination on the testing station at the point in the examination where the failure occurred, and wherein the user will not be penalized for the time that questions are not available.

14-19. (Canceled)

20. (Previously Presented) A method of managing the state of an examination, the method comprising:

delivering identification of the examination to be administered on one or more testing stations to a server computer;

creating an initial state object on the server computer wherein the initial state object defines the initial state of the examination;

delivering the initial state object to the one or more testing stations;

recording each user interaction with the one or more testing stations;

delivering changes to the initial state object from the one or more testing stations to the server computer based on each user interaction at the same time that each user interaction occurs; and

restarting the examination following failure of the testing station wherein the initial state object and the changes to the initial state object stored on the server computer are used to recreate the examination on the testing station at the point in the examination where the failure of the testing station occurred, and wherein the user will not be penalized for the time that questions are not available.

21-27. (Canceled)

EVIDENCE APPENDIX

NONE

(No evidence is being submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132, nor is there any other evidence entered by the Examiner or relied upon by the Applicant)

RELATED PROCEEDINGS APPENDIX

NONE

(There are no related proceedings)